

### Amendments to the Claims

Please revise the set of claims to read as follows:

1. (Currently amended) A method for treating a glass surface, the method comprising:

applying to the surface a [[A]] composition comprising a mixture of:

a) an organosilane of the formula  $R_nSiX_{4-n}$ , wherein n is an integer of from 0 to 3; and R is, independently, a nonhydrolyzable organic group, and each X is, independently, a hydrolyzable group; with

b) an ether of the formula R-O-R, wherein R is, independently, an organic group, and the ether has a hydroxy functionality;

wherein the composition provides hydrophobic surface treatment to the surface treated with the composition.

2. (Currently amended) A method for treating a glass surface, the method comprising:

applying to the surface a [[A]] composition comprising a mixture of:

a) an organosilane of the formula  $R_nSiX_{4-n}$ , wherein n is an integer of from 0 to 3; and R is, independently, a nonhydrolyzable organic group, and each X is, independently, a hydrolyzable group; with

b) an ether of the formula R-O-R, wherein R is, independently, an organic group, and the ether has a hydroxy functionality, wherein the ether is a glycol ether;

wherein the composition provides hydrophobic surface treatment to the surface treated with the composition.

3. (Currently amended) The method ~~composition~~ of claim 2, wherein the ether is selected from dipropylene glycol butyl ether, propylene glycol butyl ether, and dipropylene glycol propyl ether.

4. - 6. (Cancelled)

### Remarks

The previously pending claims (1-6) were rejected under §102 and § 103. Claims 4-6 have now been cancelled. Claims 1-3 have now incorporated a feature of the claim 4-6 subject matter, albeit in method claim format. In view thereof, reconsideration is respectfully requested.

As an initial matter, Applicant notes that the Office Action emphasized that a new use/property is not given significant weight in the context of a product claim, particularly with respect to anticipation issues. To address this concern, all claims now are presented as method claims. In that format, the limitation to providing hydrophobic surface treatment of a glass surface is given weight, even in an anticipation context.

In any event, U.S. patent 4,732,858 to Brewer *et al.* teaches an adhesion promoter particularly useful in producing microelectronic components (see column 2, lines 30-35 of Brewer *et al.*). There is no teaching or suggestion of treating glass to create a hydrophobic surface. Adhesion promoters would be expected to cause adherence, and thus are a teaching away from a function of repelling a substance. Thus, the pending anticipation rejection based on Brewer *et al.* is clearly overcome by the amendment, and there is no basis for otherwise applying Brewer *et al.*

U.S. patent 4,551,541 to Hanisch teaches a sealing composition particularly useful in polyurethane sealing compositions (see column 1, lines 61-65 of Hanisch). Again, there is no teaching or suggestion of treating glass to create a hydrophobic surface. Polyurethane sealing compositions would be expected to facilitate adhesion. Again, an adhesion/sealing function is a teaching away from a function of repelling a substance. Thus, the pending anticipation rejection based on Hanisch is

clearly overcome, and it is respectfully contended that the pending rejection of claim 3 for obviousness in view of Hanisch is also overcome. The pending rejection of claim 6 is mooted by the cancellation of that claim.

U.S. patent 4,908,065 to Tanitsu *et al.* describes a coating solution for adhering a metal oxide film. Such a coating would be expected to be adherent, and constitute a further teaching away from a repelling substance. In any event, there is no teaching in the reference of coating glass to create a hydrophobic surface. Thus, the pending anticipation rejection based on Tanitsu *et al.* is clearly overcome, and it is respectfully contended that Tanitsu *et al.* does not render even claim 3 obvious. The pending rejection of claim 6 is mooted by the cancellation of that claim.

U.S. patent 5,514,211 to Marks *et al.* was cited as describing a composition particularly suited for increasing the adhesion of subsequent coatings (e.g., paint) to metals (see column 1, lines 8-14 of Marks *et al.*). Again, this is a teaching away from a substance that facilitates a material being repelled. Thus, the pending anticipation rejection based on Marks *et al.* is clearly overcome, and it is respectfully contended that Marks *et al.* does not render the present invention obvious.

U.S. patent 5,008,153 to Hayes *et al.* was cited as describing a pretreatment adhesion solution for thin metallic films, such as silver, which are applied to substrates (see column 1, lines 10-13 of Hayes *et al.*). This again is about sticking something to a substrate not repelling it. Again, no function is taught to provide a hydrophobic surface.

With respect to the Office Action's general comments, Applicant notes that:

1. none of the references exemplifies an "identical" formulation to a formulation that Applicant exemplifies. It is assumed that the Office Action is

asserting that some of the previously pending product claims of Applicant would have read on a formulation of the prior art. However, merely because a prior art formulation contains in it all the elements in a claim does not establish that the formulation has a claimed property as well. Here, there were differences in the presence of other additives, in percentages present of even the claimed components, and of the selection and combination of the claimed constituents within each sub-genus claim.

For example, if one were to claim a method of cleaning a window with a cleaner of a specified formulation to provide a transparent clean window, and if the prior art taught the identical composition components albeit with white paint, using that prior art composition could not result in a clean transparent window. Hence, any assertion that because a claim is so broad as to cover a particular composition it must have the same advantages as claimed, is erroneous. The result serves as a further limitation of the claim.

2. With respect to the Office Action's comment that some silane coatings are known to provide hydrophobic properties in some context, Applicant respectfully requests a citation of a particular reference that is being relied on for this purpose so that Applicant can determine the pertinence of the reference. Until reviewing that art Applicant traverses any reliance on any purported general knowledge about silanes without specific reference citation. In this regard, it should be noted that a teaching that a particular compound alone has a particular property is different from a teaching that a particular compound in the context of other specified materials (e.g. a particular ether and on glass) will have that property.

Conclusion

Therefore, reconsideration of pending, further amended, claims 1-3 is respectfully requested. No additional fees are believed to be required for entry of this amendment. However, should any additional fees be needed, please charge Deposit Account No. 17-0055 for the amount of the fees.

Respectfully submitted,

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